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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/872,623      | 06/02/2001  | Thomas T. Andersen   | 010.00121           | 2288             |

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05/21/2003

Ivor R. Elrifi, Esq.  
Mintz Levin  
One Financial Center  
Boston, MA 02111

EXAMINER

HUFF, SHEELA JITENDRA,

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 05/21/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/872,623

Applicant(s)

ANDERSEN ET AL.

Examiner

Sheela J Huff

Art Unit

1642

-- The MAILING DATE of this communication appears in the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 16-22 is/are pending in the application.
- 4a) Of the above claim(s) 16-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-12 is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

The amendment filed on 4/23/03 has been considered. Applicant's arguments are deemed to be persuasive-in-part.

Claims 1-12 and 16-22 are pending.

Claims 16-22 are withdrawn from consideration.

The rejection of Claims 1-2 under 35 U.S.C. 102(a) as being anticipated by Mesfin et al. Proc. Of the American Assn. For Cancer Research vol. 41 p. 375 (3/00), Abstract #2380 is withdrawn in view of applicant's amendment.

The rejection of claims 1-2, 13-14 under 35 U.S.C. 102(b) as being anticipated by Vakharia et al, Breast Cancer Research and Treatment vol. 63 p. 41 (2000) is withdrawn in view of applicant's amendment.

The rejection of claims 1-3, 6-8 and 13-14 under 35 U.S.C. 102(b) as being anticipated by Mizejewski US 5707963 is withdrawn in view of applicant's amendment.

The rejection of claims 1 and 13-15 under 35 U.S.C. 103(a) as being unpatentable over Mizejewski US 5707963 or Krystal et al US 6348567 in view of applicant's admission on page 9, lines 20-25 of the specification is withdrawn in view of applicant's amendment.

***Response to Arguments***

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 5 remain rejected under 35 U.S.C. 102(a) as being anticipated by Mesfin et al. Proc. Of the American Assn. For Cancer Research vol. 42 p. 778 (3/01), Abstract #4178. The reasons for this rejection are of record in paper no. 12, mailed 1/23/03. Please note that the reference date has been corrected to read 3/01 not 3/00).

Applicant argues that EMTOVNPG is found in 60/208614. While this peptide is found the other peptides in the claim are not found and a claim as a whole only gets one filing date (Studiengesellschaft Kahle m.b.H. v. Shell Oil Co. 42 USPQ2d 1674, 1677 (Fed. Cir 1997)).

~~Claims 1-3, 5 remain rejected under 35 U.S.C. 102(a) as being anticipated by Jacobson et al Cancer Detection and Prevention vol. 24 (Supp. 1) 2000. The reasons for this rejection are of record in paper no. 12, mailed 1/23/03. This rejection is now made under 102a not 102b because the reference was available in 8/00 which is less than one year prior to the filing date of 6/2/01.~~

Claims 1-2 remain rejected under 35 U.S.C. 102(b) as being anticipated by Cantley et al US 5532167, This reference discloses SEQ ID No. 36 which reads on a analog of SEQ Id no. 6 of the instant invention. The reasons for this rejection are of record in paper no. 12, mailed 1/23/03.

Applicant argues that the peptide in the reference does not have antiestrotrophic activity. This is an inherent property of the peptide.

Applicant argues that the peptide in the reference does not read on analog and asserts that the three side chains which are positively charged make the peptide devoid of said activity. This is an assertion and applicant has not provided any objective evidence to support this. Additionally, applicant has not specifically defined what is encompassed by the terminology "analog" and therefore the peptide of the references reads on an analog of SEQ ID No. 6.

Claims 1-4 remain rejected under 35 U.S.C. 102(e) as being anticipated by Krystal et al US 6348567. The reasons for this rejection are of record in paper no. 12, mailed 1/23/03.

Applicant's arguments have been addressed above.

***Allowable Subject Matter***

Claims 9-12 are allowed.

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Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheela J Huff whose telephone number is 703-305-7866. The examiner can normally be reached on T,Th 6am-12pm and alternate Mondays 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Sheela J Huff  
Primary Examiner  
Art Unit 1642

sjh  
May 20, 2003